

Application No. 09/659363
Amendment dated January 9, 2005
After Final Office Action of November 29, 2005

Docket No.: 013436.0234PTUS

REMARKS

Claims 1 – 15 are pending in the present application. In a Final Office Action dated 29 November 2005, the Examiner withdrew his allowance of claims 16 – 18 and rejected claims 1 – 15 under 35 U.S.C. 102(e) as being clearly anticipated by United States Patent No. 6,490,274 issued to Kim. Applicant presents the following remarks in support of the patentability of claims 1 – 15.

Anticipation Rejection of Claims 1 – 15

In the last Office Action, the Examiner objected to dependent claims 16 – 18 as dependent on rejected base claims, and indicated these claims would be allowable if amended to include the limitations of the base claims and any intervening claims. In response thereto, Applicant filed an Amendment dated 09 November 2005 wherein Applicant amended independent claims 1, 6, and 11 to include the limitations of the corresponding one of allowable dependent claims 16 – 18, respectively. Applicant also cancelled claims 16 – 18, since the limitations of these claims were recited in independent claims 1, 6, and 11. The Examiner has now removed the allowance of these claims and instead has issued a new rejection of the remaining claims 1 – 15 as anticipated by the Kim Patent.

In the present Office Action, the Examiner rejected claims 1 – 15 under 35 U.S.C. 102(e) as being clearly anticipated by United States Patent No. 6,490,274 issued to Kim, noting with respect thereto:

Regarding claims 1, 6, and 11, Kim teaches a method and system for internet (254) cable phone (208, packet based terminal device) telephony service over internet protocol (IP) (addressing system) for enabling a calling party using a public switched telephone network (PSTN, 260) phone (256, circuit based terminal device), which is addressable via a telephone number, to initiate a communication connection to a called party who is using an IP addressable cable phone (208, a packet-based terminal device, which is addressable via an IP address) (See Fig. 2) comprising directory information base (DIB, 218 as data storage means), for storing data in as a memory indicative of a correspondence between at least one IP address assigned to a 1st cable phone (208, said called party's packet-based terminal device) and a corresponding PSTN telephone number assigned to 1st cable phone (208, said called party's circuit-based terminal device),
1st head end unit (202 as terminal device location means), responsive to receipt of data from said calling party indicative of said called party's telephone

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numbers corresponding to 1st cable phone (208, said called party's circuit-based terminal device), for retrieving data from DIB (218, said memory indicative of said IP address) assigned to a 1st cable phone (208, called party's packet-based terminal device), and

1st router (216 as communication connection means), for establishing a communication connection between 1st PSTN phone (256, said calling party's circuit-based terminal device) to 1st cable phone (208, said called party's packet-based terminal device) (See Fig. 2, Col. 3, lines 53-67),

wherein the 1st Internet telephony Gate ITG (220) interacting with above units also performs as local exchange carrier function, and selection of either connection of circuit based terminal via PSTN through ITG (step 308) or packet based terminal via IP telephone (step 307) (See Fig. 3, Col. 4, lines 35-54).

Applicant's Characterization of the Reference

Applicant has reviewed the cited Kim reference and the Examiner's clearly stated grounds for rejection, and presents the following arguments in support of the patentability of Applicant's claims 1 - 15.

The cited Kim Patent discloses a cable network telephony service system wherein each cable phone has both a telephone number and an IP address. A directory unit stores the IP address corresponding to the telephone number of the cable phone, so that when a cable phone initiates a call, the system determines whether the destination is another cable phone or a PSTN phone. If the destination is another cable phone, the dialed telephone number is automatically translated into the IP address of the second cable phone to make the call connection through the cable system. Thus, each cable phone has both a ten digit dialed telephone number and an IP address, consuming two access numbers for each device.

As described in the Kim Patent (column 4, line 1 to column 5, line 25), each cable phone has both a telephone number and an IP address and the telephony service system therefore includes:

IP (Internet protocol) addresses corresponding to telephone numbers of the first through fourth cable phones 208, 214, 246 and 248 are stored in the first and second DIBs 218 and 264. The first headend unit 202 receives a telephone number from the first or second cable phone 208 or 214 through the first or second cable modem 206 or 207 and the first hubs 204 and 205 to read the IP address corresponding to the telephone number stored in the first DIB 218. Also, the first

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headend unit 202 determines the connection audio session to set a call path with the third or fourth cable phone 246 or 248. The first and second cable phones 208 and 214 connect calls to the third and fourth cable phones 246 and 248 through the first and second headend units 202 and 242 and the first router 216. The first and second routers 216 and 250 set a call path between the first and second network segment units 200 and 240, with the first and second ITGs 220 and 262 or with the Internet 254. Thus, a user of one of the headend units can call a user of another headend unit or the PSTN phone.

The first and second network segment units 200 and 240 of FIG. 2 are formed in a tree type network using hubs 204, 205, 244, . . . , and it is assumed that each of the cable phones is an Ethernet phone including an Internet protocol, capable of receiving an audio signal of the Internet.

A user inputs the telephone number of a receiver to the first or second PSTN phone 256 or 258 (step 400). One of the first through fourth cable phones 208, 214, 246 and 248 is the receivers. The PSTN 260 is connected to the first and second ITGs 220 and 262 through the T1/T2/T3/E1 network (step 402). If the PSTN 260 is connected to the first and second ITGs 220 and 262, the routers 216 and 250 set a call path between the ITGs 220 and 262 and the first and second headend units 202 and 242. If the call path is set, the first and second headend units 202 and 242 check the first and second DIBs 218 and 264 (step 404), and thus it is determined whether there is an IP address corresponding to the telephone number input from the first or second PSTN phone 256 or 258 (step 406). If it is determined in step 406 that there is an IP address, peer-to-peer IP telephony is set between the first and second PSTN phone 256 or 258 and one of the first through fourth cable phones 208, 214, 246 or 248 (step 408) to connect the call (step 410).

Applicant's Claimed Invention

In contrast, Applicant's packet-based terminal device addressing system provides a calling party with the ability to address multiple called party terminal devices via a single telephone number that is shared by all of the called party's terminal devices. Thus, both circuit-based and packet-based terminal devices owned by a subscriber can be accessed via a single listed telephone number without consuming additional telephone numbers. The packet-based terminal device addressing system presumes that the owner of the circuit-based terminal device also owns at least one packet-based terminal device and therefore reuses the telephone number of the called party's circuit-based terminal device for all of the called party's packet-based terminal devices, so multiple terminal devices share the same telephone number.

The calling party, using a circuit-based terminal device such as a traditional telephone or video telephone, initiates a call to a called party, using the called party's telephone number. The

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present packet-based terminal device addressing system translates the telephone number of the circuit-based terminal device to a list of the called party's packet-based terminal devices. The calling party can then review the list of the called party's packet-based terminal devices and select and connect to one of the called party's packet-based terminal devices. Thus, the one telephone number is used to address multiple devices: a circuit-based phone and at least one packet-based terminal device.

Claim Chart

Applicant presents the following claim chart to indicate the differences between Applicant's invention as recited in independent claim 1 (and similarly for independent claims 6 and 11) and the Kim Patent cited by the Examiner. The elements contained in Applicant's independent claim 1 that are not shown or suggested by the cited Kim Patent are underlined to illustrate these differences.

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Kim Patent

The Kim Patent discloses a cable network telephony service system that interconnects cable phones, wherein each cable phone has both a telephone number and an IP address.

The system of the Kim Patent uses both a telephone number and an IP address for each cable phone. Each telephone number-IP address pair therefore addresses only one cable phone, not multiple terminal devices.

The Kim Patent is directed to a cable system that receives a telephone number from the cable phone, not the Public Telephone Switched Network via a Local Exchange Carrier serving the calling party.

The system of the Kim Patent uses both a telephone number and an IP address for each cable phone. Each telephone number-IP address pair therefore addresses only one cable phone, not multiple terminal devices.

The Kim Patent does not provide the calling party with any list of circuit-based terminal devices or packet-based terminal devices.

If the destination is another cable phone, the dialed number is automatically translated into the IP address of the second cable phone to make the call connection. The calling party is not provided with any list of circuit-based terminal devices or the ability to select a packet-based terminal device from a list.

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Applicant's Claim 1

A packet based terminal device addressing system for enabling a calling party using a circuit based terminal device, which is addressable via a telephone number, to initiate a communication connection to a called party who is using a packet-based terminal device, which is addressable via an IP address, comprising:

means for storing data in a memory indicative of a correspondence between at least one IP address assigned to a called party's packet-based terminal device and a telephone number assigned to said called party's circuit-based terminal device;

means, responsive to a calling party, connected to the Public Telephone Switched Network via a Local Exchange Carrier serving said calling party, dialing the telephone number assigned to said circuit-based terminal device of said called party, for transmitting said telephone number to a Local Exchange Carrier serving said called party;

means, responsive to receipt of data from said calling party by said Local Exchange Carrier serving said called party and indicative of said called party's telephone number corresponding to said called party's circuit-based terminal device, for retrieving data from said memory indicative of said IP address assigned to a called party's packet-based terminal device,

comprising:

means for providing said calling party with a list of said called party's circuit-based terminal devices and said called party's packet-based terminal devices

means, responsive to said calling party selecting one of said called party's circuit-based terminal devices and said called party's packet-based terminal devices, for identifying a communication service serving said selected one of said called party's circuit-based terminal devices and said called party's packet-based terminal devices; and

means for extending a communication connection that exists from said calling party's circuit-based terminal device to said Local Exchange Carrier serving said called party, to said called party's packet-based terminal device.

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Thus, there is a fundamental difference between Applicant's claimed packet-based terminal device addressing system and the cable network telephony service system of the cited Kim Patent. Applicant's system uses a single telephone number for both the called party's circuit-based terminal device and their multiple packet-based terminal devices, whereas the Kim Patent uses a telephone number and a IP address for each cable phone. The Kim Patent, therefore, uses a telephone number and an IP address for each cable phone, while Applicant's system uses a single telephone number for multiple devices.

As shown in the claim chart, the Kim Patent fails to show or suggest sharing a telephone number among multiple terminal devices, as is specifically recited in Applicant's independent claim 1. The Kim patent also fails to show or suggest providing a calling party with a list of the called party's packet-based devices associated with the telephone number to thereby enable the calling party to select one of the called party's terminal devices as the destination of the call.

Therefore, Applicant believes that Applicant's claim 1 is allowable under 35 U.S.C. 102(e) over United States Patent No. 6,490,274 issued to Kim since the Kim Patent fails to disclose all of the elements recited in Applicant's independent claim 1. Applicant also believes that independent claims 6 and 11 are also allowable under 35 U.S.C. 102(e) over United States Patent No. 6,490,274 issued to Kim for the reasons articulated for independent claim 1. Applicant also believes that dependent claims 2 - 5, 7 - 10, and 12 - 15 are allowable under 35 U.S.C. 102(e) over United States Patent No. 6,490,274 issued to Kim since these claims depend on allowable base claims.

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Summary

Applicant respectfully requests a Notice of Allowance of claims 1 – 15 in this application in light of the remarks set forth herein. The undersigned attorney requests Examiner Chang to telephone if a conversation could expedite the prosecution of this application. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1848, under Order No. 013436.0234PTUS from which the undersigned is authorized to draw.

Respectfully submitted,
PATTON BOGGS LLP

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